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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFERY M. ENRIGHT

Appeal 2008-004397
Application 09/991,748
Technology Center 3600

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Jeffery M. Enright (Appellant) has filed a Request for Rehearing, under 37 C.F.R. § 41.52, of the Decision by the Board affirming-in-part the rejection of claims 1-39 under 35 U.S.C. §102(e) as being anticipated by Stinson. The decision of the Examiner to reject claims 1, 6-15, 17-19, 21-27, 29, 30, 33, and 35-39 was affirmed and the decision of the Examiner to reject claims 2-5, 16, 20, 28, 31-32, and 34 was reversed. The Request indicates certain points in particular that the Appellant believes the Board misapprehended or overlooked in reaching its decision.

The major challenge to the Decision surrounds the Board's construction of the claim phrase "electronic signature" and the decision in consequence to that construction to affirm the rejection of claims 1, 6-15, 17-19, 21-27, 29, 30, 33, and 35-39 under §102. The Request also challenges the Board's construction of the claim terms "applying" and "apply," which terms appear in claims 2-5, 16, and 20, and 28, 31, 32, and 34, respectively, notwithstanding that their rejection under §102 was reversed.

We will grant the Request to the extent that we modify our reasoning to make it more clear as explained below. To the extent that it seeks to change our decision to affirm the rejection of claims 1, 6-15, 17-19, 21-27, 29, 30, 33, and 35-39, the Request is granted-in-part. We grant the request to the extent we reverse the rejection of claim 30, but deny the request to reverse the decision to affirm the rejection of claims 1, 6-15, 17-19, 21-27, 29, 33 and 35-38.

DISCUSSION

The Request is divided in four sections. We will address each section in turn.

“I. Recent Relevant Decision By The Federal Circuit” (Request 1)

In Section I of the Request, the Appellant cites *In re Skvorecz*, 580 F.3d 1262 (Fed. Cir. 2009) for the principle that “[t]he protocol of giving claims their broadest reasonable interpretation during examination does not include giving claims a legally incorrect interpretation.” Request 1, citing *Skvorecz*, 580 F.3d at 1267. The Appellant then asserts that “Board gave claims a legally incorrect interpretation; misconstrued the transition language signal “comprising”; and did not properly find anticipation as a matter of law.” Request 1.

We respond as follows.

In this section of the Request, the Appellant does not explain in what way the “Board gave claims a legally incorrect interpretation; misconstrued the transition language signal “comprising”; and did not properly find anticipation as a matter of law.” Accordingly, this section of the Request does not indicate in particular what the Appellant believes the Board misapprehended or overlooked in reaching its decision and therefore the discussion in this section is not persuasive as to error in the Decision.

We make the following comments about *Skvorecz*. The aforementioned principle is well-accepted. Otherwise, we fail to understand the relevance of *Skvorecz* to this case.

In *Skvorecz*, the claims recited structure the prior art did not identically describe. The Board had found the Examiner established a prima

facie case of anticipation based on a structural similarity between the claimed device and that of the prior art reference. But the Board misinterpreted the claim phrase “comprising a plurality of offsets ... for laterally displacing each wire leg” to mean that “not every wire leg is required by claim 1 to include offsets”. *Skvorecz*, 580 F.3d at 1267. The court determined that that interpretation of the claim was incorrect. “Here the examination expedient of “broadest reasonable interpretation” was incorrectly applied to interpret “comprising” to mean that not all the *Skvorecz* wire legs need have offsets, despite the claims that state that “each wire leg” has an offset.” *Skvorecz*, 580 F.3d at 1268. Accordingly, though *Skvorecz* involves a question of claim construction, there is no indication that any claim term had a disputed meaning. The meaning of the term “comprising” does not appear to have been in question. The only question was what elements in the claimed device the term “comprising” was referring to. We understand the question in this case to be the meaning one of ordinary skill in the art would ascribe to the particular claim phrase “electronic signature.” *Skvorecz* is not concerned with a question of determining the meaning to be given a claim term.

“II. The Burden of Proof Was Misapprehended By The Board” (Request 1)

The Appellant states that “[t]he record reflects that the Board only based its Decision on whether the Appellants’ [sic] arguments proved error in the Examiner’s rejection.” Request 2. According to the Appellant, “[t]he Board misapprehended its authority in requiring Appellants to prove non anticipation rather than evaluating whether the Examiner had met the burden of establishing a prima facie case of anticipation.” Request 2. The

Appellant finds that the Board misapprehended the burden of proof and for that reason the Decision is in error.

We agree that the wording of the Decision could have been more balanced. We can understand how one reading the Decision would come away with the view that the panel was placing the entire burden on the Appellant to show that no prima facie case of anticipation was made, without placing any burden on the Examiner to establish a prima facie case in the first instance. But that is not a fair characterization of the process by which the panel reached its decision.

It is well accepted that the PTO must first establish a prima facie case. This has been recently reiterated in *In re Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential). This involves setting forth a factual basis for the rejection. See *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984) (the initial burden of proof is on the USPTO “to produce the factual basis for its rejection of an application under sections 102 and 103”). In that regard, the Decision very clearly first sets out Findings of Fact directed to the question of claim construction and the scope and the scope and content of Stinson, the reference used by the Examiner to reject as anticipated the subject matter of the claims on appeal. See Decision 3-5. The eighteen facts listed there are the factual basis the panel relied upon in finding support for a prima facie case of anticipation. We should have so stated. We should have stated that, in light of the indicated facts, the Examiner appears to have established a prima facie case of anticipation in the first instance.

Otherwise, the panel correctly proceeded to evaluate the anticipation rejection based on the issues raised by the Appellant in light of the

arguments and evidence provided in the briefs. *See* the Analysis section of the Decision. *See Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010):

The panel then reviews the obviousness rejection for error based upon the issues identified by appellant, and in light of the arguments and evidence produced thereon. *See Oetiker*, 977 F.2d at 1445 (“In reviewing the examiner's decision on appeal, the Board must necessarily weigh all of the *evidence and argument*.”) (emphasis added); *see also* 37 C.F.R. §41.37(c)(1)(vii) (appeal brief must include “the contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis therefore, with citations of the statutes, regulations, authorities, and parts of the record relied on”). Specifically, the Board reviews the particular finding(s) contested by an appellant anew in light of all the evidence and argument on that issue.

In that regard, each argument that was raised in the briefs was addressed and an explanation given as to why we found the argument unpersuasive in showing that the “Examiner erred in rejecting” the claims on appeal. We agree that the Decision could have worded this better. Rather than saying that the Appellant had not shown error, it may have been better had the panel indicated instead that each of the Appellant’s argument had not overcome the *prima facie* case of anticipation. Be that as it may, we do not find that the Board misapprehended the burden of proof.

We will grant the Request to the extent that we modify our original reasoning to make the burden of proof clearer, as explained above. But to the extent that it seeks to change our decision to affirm the rejection of claims 1, 6-15, 17-19, 21-27, 29, 30, 33, and 35-39, the Request is denied.

“III. The Decision Is Based On Critical Factual Errors” (Request 3)

“Error #1” (Request 4)

The Appellant argues that the “Board erred in imputing an incorrect definition to the [claim] term “electronic signature.” Request 4.

The claim term “electronic signature” appears in every claim on appeal.

In the Decision, the Board found the following (Findings of Fact, Decision 3-4):

1. The Specification does not contain an express definition of “electronic signature.”
2. The Specification states that a user’s image may serve as an electronic signature. Specification 66:6-7
3. A definition of “electronic signature” is “an electronic sound, symbol, or process attached to or associated with a contract or other record and used as the legal equivalent of a written signature.” The American Heritage® Dictionary of the English Language, (4th Ed. 2004), <http://dictionary.reference.com/browse/e-signature>. (Accessed: September 16, 2009).

The Appellant makes five arguments in support of the view that the Board’s definition for “electronic signature” (i.e., an electronic sound, symbol, or process attached to or associated with a contract or other record and used as the legal equivalent of a written signature) is in error.

The first argument is that the Board improperly relied upon a 2004 dictionary when the application on appeal was filed Nov. 23, 2001 and further claims benefit to a provisional application filed Nov. 27, 2000. We

agree. Claim terms must be given the meanings they would have had at the time of the invention. “[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005). Accordingly, we should have relied on an earlier-published dictionary. In that regard, we will adopt the definition the Appellant urges (Request 4, as part of the second argument), as that definition does not appear to be substantively different from the one the Board applied in the Decision but it is one known to have existed at the time of filing.

Accordingly, we will modify Finding of Fact 3 in the Decision (Decision 4) to read as follows:

3. A definition of “electronic signature” is “an electronic sound, symbol, or process, attached to or logically associated with a contract or other record and executed or adopted by a person with the intent to sign the record.” 15 USC § 7006 (Pub. L. 106-229, title I, Sec. 106, June 30, 2000, 114 Stat. 472).

In light of our adoption of the meaning of “electronic signature” urged by the Appellant, we need not address the four remaining arguments.

Accordingly, we will grant the Request to the extent that we modify our original finding as to the meaning of “electronic signature” so that it accords with one that existed at the time of filing, as explained above. But to the extent that it seeks to change our decision to affirm the rejection of claims 1, 6-15, 17-19, 21-27, 29, 30, 33, and 35-39, the Request is denied.

“Error #2” (Request 6)

Before we address this section of the Request, it is helpful to first fully construe the scope of the claim.

Taking claim 1², as representative, the claimed invention is a process comprising three steps.

In the first step, a document requiring a signature to achieve a legal effect is provided in an automated banking machine. An ATM is a type of automated banking machine covered by the claimed process. *See* Specification 1:16-17. Checks are a type of “document requiring a signature to achieve a legal effect” covered by the claimed process. *See* Specification 4:4. Accordingly, the first step covers providing a check in an ATM. There can be no dispute that Stinson expressly describes this step. *See* col. 7, ll. 46-47: “the ATM 350 prompts the customer to endorse the check and to insert the check into the check reader.”

² 1. A method comprising:

- (a) providing in an automated banking machine a document requiring a signature to achieve a legal effect;
- (b) receiving at least one input from a user of the machine indicative that the user agrees that the user’s electronic signature shall include data corresponding to at least one image of at least a portion of the user;
- (c) acquiring the data corresponding to at least one image of the user through operation of the machine.

In the second step, at least one input is received from a user of the machine. “The” machine presumably refers to the automated banking machine of the first step, e.g., an ATM. The step covers receiving any type of input, so long as it functions to give an “indication that the user agrees that the user’s electronic signature shall include data corresponding to at least one image of at least a portion of the user.” The function to “indicat[e] that the user agrees that the user’s electronic signature shall include data corresponding to at least one image of at least a portion of the user” requires the input to give an indication that the user’s electronic signature shall include data corresponding to an image of at least a portion of the user. In other words, the function of the input in the second step of the claimed method is to indicate agreement that the user’s electronic signature shall include data corresponding to an image of at least a portion of the user. (We note that, strictly speaking, the claim phrase “the user’s electronic signature” does not have antecedent basis in the claim. But an electronic signature is implicitly required, without which there would be no need to receive the input.)

The “electronic signature” reasonably broadly covers a process. This was stated in the Decision (See Decision 3: Finding of Fact 3 and at Decision 7: “It is a process associated with a check that is the legal equivalent of a written signature.”) and we see no reason to change that view, even though we are now adopting a more appropriate meaning for “electronic signature” (*see supra*). As with the previous definition, an “electronic signature” covers an electronic process - one attached to or logically associated with a contract or other record and executed or adopted by a person with the intent to sign the record. Where the contract or other

record is a check, an “electronic signature” is an electronic process attached to the check that a person intends to sign.

It should be noted that the claim does not specify who or what receives the input of the second step. It could be received by any entity. The input need not be received by “the machine.” Furthermore, the claim does not require the steps to be practiced in a continuous sequence. Accordingly, the step “at least one input that is received from a user of the machine” could occur apart from the other two steps, e.g., before providing a check in an ATM and acquiring the image. Be that as it may, the claim is nevertheless reasonably broadly construed to cover practicing the second step in concert with the first and third steps.

That means the second step covers an ATM receiving an input indicative of an agreement that the user’s electronic process attached to the check the user intends to sign shall include data corresponding to an image of at least a portion of the user.

In the third step, data corresponding to at least one image of the user is acquired through operation of the machine. This step reasonably broadly covers taking a picture of the user at the time a user interacts with an ATM.

Putting it all together, claim 1 is reasonably broadly construed to encompass a process comprising (a) a user putting a check into an ATM; (b) the ATM receiving an input indicative of an agreement that the user’s electronic process attached to the check the user intends to sign shall include an image of the user; and, (c) taking the image of the user at the time the user interacts with an ATM.

According to the Specification, the claimed invention can be practiced using an ATM (22:10), inputs through an input device on the machine

(66:14-15), an endorsable check (67:16), and a camera at the ATM (23:6). *See* Fig. 1. A user presents the check into the ATM, inputs agreement that an image of the user may be used, and the camera takes the image.

When the claim is given the broadest reasonable construction in light of the Specification as it would be interpreted by one of ordinary skill in the art, we can discern no difference between the claimed process and that of Stinson. The claimed process reasonable broadly reads on that of Stinson.

In Stinson, a user endorses a check on the back and deposits it in an ATM machine. Col. 7, ll. 46-47. The ATM then scans the front and reverses sides of the check. Col. 7, ll. 49-50. A camera at the ATM machine takes an image of the depositor. Fig. 1, element 125. The image is used to verify the identity of the depositor. Col. 5, ll. 20-22. The user may be asked to press an “OK” button before taking the image if the user is wearing a hat and sunglasses and they are removed. Finding Fact 15, Decision 5, citing Fig. 16C in Stinson. In any case, “the customer enters” an identification number before the image is taken. Col. 8, ll. 25-28. Verification occurs when the taken-image matches a stored image. Col. 8, ll. 45-47. When the check is endorsed, validated, and the image matches the stored image, the depositor gets a payback amount. Col. 8, ll. 62-65 and col. 9, ll. 53-63. *See* Findings of Fact, Decision 4-5.

The Appellant argues that the Stinson process is not the same as that which is claimed. According to the Appellant, Stinson does not teach “a user ‘image’ or ‘the taking of the image’ ‘is the legal equivalent of a written signature.’” Request 6. This is not a persuasive argument.

The Appellant would have us construe the claim such that the user’s image is an electronic signature and that the input the ATM receives is

indicative of an agreement that the image “is” an electronic signature. While that may be what is disclosed in the Specification (see 67:5-7: “the user may indicate through one or more inputs through one or more input devices on the banking machine that their image or portion thereof will be their electronic image.”), that is not what is claimed. The claim is broader than that. According to the claim, the electronic image shall “include” the image. There is no requirement that the image “be” a person’s legally binding signature. We will not narrow the scope of the claim by importing a limitation to make the image in the claim be a person’s legally binding signature.

To the extent the Appellant may have understood the Board to have construed the user’s image in the claim to be an electronic signature in affirming the rejection; we take this opportunity to clarify our position. As we stated in the Decision, we construed the Stinson process - endorsing, validating, and verifying the image via the ATM machine – as the “electronic signature” as that claim term is ordinarily/customarily understood. We clearly said this on page 8 of the Decision: “We agree with the Examiner that the taking of the image of the user reads on an “electronic signature” as we have construed the term above. It is a process associated with a check that is the legal equivalent of a written signature. Further, we find that the fact that Stinson requires that the check be endorsed by writing does not preclude a finding that Stinson also requires an electronic signature. The check cashing machine will not cash a check without a user image.” Emphasis added. Even under Appellant’s own definition, that we have adopted supra, an “electronic signature” need not be necessarily an image but can be a process. The Appellant does not address our

construction of “electronic signature” as a process. The Appellant argues that “electronic signature” implies intent to have the “image” constitute the user’s legal signature. But such an argument presumes that image mentioned in the claim is the “electronic signature”. The claim says instead that the user’s “electronic signature shall include data corresponding to at least one image of at least a portion of the user.” As we have already explained, the claim does not require the electronic signature to be an image but only to include one. Thus, the claim reasonably broadly covers a process that includes an image. Given that construction, the claim reads on Stinson because Stinson provides a process that implies intent to constitute a legal effect on the part of the user – and that process includes an image.

We did not overlook a limitation to the use of an image as an “electronic signature” because that is not clearly recited in the claims. The Board in the prior decision did not find the claimed methods require the use of an image as an “electronic signature.” Nor did the Board find that Stinson described an image which could be interpreted as an “electronic signature.” To the extent the Appellant may have misunderstood the Board’s position; we hope the discussion above clarifies our position. Accordingly, we will grant the Request to the extent that we modify our original analysis to clarify the Board’s position as explained above. But to the extent that it seeks to change our decision to affirm the rejection of claims 1, 6-15, 17-19, 21-27, 29, 30, 33, and 35-39, the Request is denied.

“Error #3” (Request 7)

We do not understand this section of the Request. Apparently, the Appellant takes issue with the Board’s interpretation of the claim terms

“apply” and “indicia.” Apparently, the Appellant finds the definitions the Board gave these terms to be too limiting.

The Board never stated that these terms have only one meaning. The meanings that were given these terms were exemplary of their breadth, evidenced by the indicated common dictionary definition. Finding of Facts 4-7, Decision 4. It was necessary to consult a commonly used dictionary because no definitions for these terms were found in the Specification (which the Appellant does not dispute) and the Board sought to show that the Examiner did not reasonably broadly construe the claims as a prelude to rejection the claims. The Examiner had defined “applying” as covering printing. The Board found the term “applying” to have a broad meaning that encompasses printing. Notwithstanding the broad meaning, the Board could not find applying indicia in col. 8, ll. 11-44 as the Examiner had asserted. *See* Decision 9. Furthermore, we reversed the Examiner’s decision to reject those claims which called for “applying” indicia. We reversed the rejection of claims 2-5, 16, 20, 28, 31, 32, and 34 because we could not find indicia applied on the check as claimed and as those terms are ordinarily/customarily understood. Accordingly, we do not understand what relief the Appellant is seeking.

Accordingly, we deny the Request to the extent that it seeks any further clarification of our position as to the construction to be given the claim terms “applying” and “indicia” and, to the extent that it seeks to change our decision to reverse the rejection of claims 1, 6-15, 17-19, 21-27, 29, 30, 33, and 35-39, the Request is denied.

“IV. Other Points Misapprehended or Overlooked by the Board” (Request 9)

“Point #1” (Request 9)

Point #1 argues that Stinson requires the user to sign (i.e., endorse) a check by writing, not electronically, and does not require an image in order to cash a check. “The facts of record show that Stinson’s requirement for a *handwritten* signature teaches away from Stinson using (or ever needing) an *electronic* signature.” Request 10 (emphasis original).

The argument is unpersuasive.

“Teaching away is irrelevant to anticipation.” *Seachange Int’l Inc. v. C-COR Inc.*, 413 F.3d 1361, 1380 (Fed. Cir. 2005).

Furthermore, the claimed process does not preclude endorsing a check by writing. The first step of claimed process broadly covers providing a check to an ATM that requires endorsing with a written signature.

Finally, nothing in the claim requires providing an electronic signature in lieu of a written signature. All the claim requires is an input indicating the user agrees to include an image as part of the electronic signature, i.e., the electronic process attached to the check.

The Appellant also argues that the Board’s statement in the prior Decision that “check cashing machine will not cash a check without a user image” (Decision 8) is not true. Request 9. According to the Appellant, “Stinson does not require a user image for check cashing, [and thus] Stinson does not require an electronic signature for check cashing.” Request 9.

We do not find the argument persuasive. We do not agree that Stinson fails to disclose a “check cashing machine [that] will not cash a check without a user image.” The discussion in Stinson about the

identification software makes it clear that it is used to approve the customer, without which the check will not be cashed. *See* col. 9, ll. 36-37: “If the identification software does not approve the customer” The fact that a check may be cashed without an image does not make Stinson less applicable for teaching a machine that does require an image. Furthermore, the claimed method does not require cashing a check, let alone an image to cash a check.

“Point #2” (Request 10)

Point #2 argues that the claim requires an input that does more than indicate a user’s agreement to have an image taken. It requires the input to be indicative that user agrees to have the electronic signature include the image. We agree. But we are unable to discern any difference between Stinson’s input and that which is claimed. Both require the input to be indicative of an agreement to use an image. In Stinson, the image is intended to be used for customer approval as part of an electronic process for cashing a check. In the claimed method, the intended use of the image is to include it and the “electronic signature.” We are unable to discern the difference between an ATM receiving an input indicative that a user agrees to have an image taken for customer approval as part of an electronic process for cashing a check and an ATM receiving an input indicative that a user agrees to include it in the “electronic signature.”

“Point #3” (Request 10)

Point #3 argues “How can there be an “*identical* invention” when Stinson does not even mention “electronic signature?” Request 10 (emphasis original).

The argument is unpersuasive. There is no “*ipsissimis verbis*” test that requires the same claim terminology in the prior art in order to find anticipation. *See Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716 (Fed. Cir. 1984) (“While the teaching in the prior reference need not be *ipsissimis verbis*, nevertheless, there must be a teaching with respect to the entirety of the claimed invention.”)

Anticipation is determined by first construing the claims and then comparing the properly construed claims to the prior art. *In re Cruciferous Sprout Litigation*, 301 F.3d 1343, 1346 (Fed. Cir. 2002). There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991). But “[t]he law of anticipation does not require that the reference “teach” what the subject patent teaches. Assuming that a reference is properly “prior art,” it is only necessary that the claims under attack, as construed by the court, “read on” something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or “fully met” by it.” *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772 (Fed. Cir. 1983).

As discussed in the original Decision and clarified in this Decision on Request for Rehearing, we are of the view that the Board properly construed the claims and explained how they read on Stinson.

Accordingly, we deny the Request to the extent that it seeks to have Stinson's failure to mention the term "electronic signature" as a basis to change our decision to affirm the rejection of claims 1, 6-15, 17-19, 21-27, 29, 30, 33, and 35-39.

"Claim 17" (Request 11)

The Appellant argues that the Board did not address all the arguments in the Brief challenging the rejection of claim 17. We disagree. The Brief stated that "[f]or reasons of brevity, Appellants' remarks in support of patentability of claim 1 are incorporated herein by reference." App. Br. 23. The Brief then goes on to repeat that Stinson does not teach an input agreeing to the composition of the electronic signature. That is precisely what was argued in challenging the rejection of claim 1. *See* App. Br. 18 (In discussing the rejection of claim 1: "Stinson teaches neither an electronic signature/user image relationship nor a user agreement for that relationship.")

"Claim 18" (Request 12)

The Appellant argues that certain comments about the patentability of claim 18 shows the Board did not fully address the claim limitations or all the Appellant's argument. The only example the Appellant gives for this argument is a statement made about endorsing a check. *See* Decision 14.

We disagree. Claim 18 further limits step (c) of claim 17 such that the acquiring data corresponds to at least one image and step (b) such that the agreement input is indicative of agreement that the electronic signature include the data of step (c). This was addressed with respect to the

Appellant's arguments challenging the rejection of claim 1. There was no need for the Board to raise the fact that Stinson's process includes endorsing a check. Accordingly, we modify the Decision so that the statement "The Appellant argues that Stinson does not describe a user providing an input to an automated banking machine, where the user input indicates that the user's image data shall constitute an endorsement of the negotiable instruction" is changed to read "The Appellant argues that Stinson does not describe a user providing an input to an automated banking machine as claimed."

"Claim 21" (Request 12)

The Appellant argues that Stinson does not teach storing both data corresponding to the user agreement and the user image data. (Request 12-13) as claim 21 requires. We have reviewed Stinson.

The step at issue in claim 21 is this:

"(d) storing in at least one data store in correlated relation, *data corresponding to* the at least one agreement input received in (b) and *data corresponding to* the at least one image." Emphasis added. Step (b) of claim 17, on which claim 21 depends, is "receiving at least one input from a user of the machine indicative that the user agrees that the user's electronic signature shall include data corresponding to at least one image of at least a portion of the user."

The Appellant states: "That is, Appellants argued that Stinson does not teach storing both (1) user agreement input data and (2) acquired user image data in correlated relation" and then states: "Rather, the Board (at Decision page 8) indicates that a user (in Stinson) pressing the OK button constitutes the user's agreement input. The Board overlooks the fact that

Stinson does not *store* “OK button was pressed” data, especially in correlated relation with the user’s image.” Request 12-13. The Appellant seems to argue that this claim requires storing the agreement input as the stored data; however, the claim is broader in that it only requires “data corresponding to.” The claim is silent as to how the data “corresponds.” “Correspond” means “to be in agreement (with something).” *See Webster’s New World Dictionary* 312.(3rd Ed. 1988.)(Entry for “correspond.”) In Stinson, after the customer goes through the process of cashing a check, which includes pressing the button to have their image taken, the ATM goes through an identification process. *See* col. 8, ll. 22-40 and col. 9, lines 35-63. The claimed “data *corresponding* to the at least one agreement input received” reads on the BMP file of the image and the claimed “data *corresponding* to the at least one image” reads on the social security number, or identification number. Stinson states that the image has to match an image stored for the customer’s identification number. *See above*. The customer’s identification number is “associated in a working or other relationship” with the customer’s image. We know from col. 9, ll. 49-63 that this information is transmitted together in a data packet, so therefore it must at least temporarily have been stored in “correlated relation,” before being transmitted (it is also “correlated” by being related by customer/transaction); “correlated” meaning “closely and naturally related” (*See Webster’s New World Dictionary* 312.(3rd Ed. 1988.)(Entry for “correlate.”)).

For the foregoing reasons we do not find the arguments persuasive and accordingly deny the Request to the extent that it seeks to change our decision to affirm the rejection of claim 21.

“Claim 22” (Request 13)

The Appellant points to the discussion in Decision about claim 22 but where claim “21” is mentioned. Decision 16. We modify the second line on page 16 of the Decision by changing “21” to “22.”.

“Claim 26” (Request 13)

The claim calls for a controller “to cause the at least one output device to ask the user of the machine if the user agrees that image data corresponding to at least one imaged portion of the user shall constitute an electronic signature of the user for purposes of signing the document.” The Decision relied on the fact that Stinson (Fig. 16) “ask[s] the user to press an “OK” button before the image is taken.” Decision 17.

The Appellant argues that Stinson’s teaching is not an “asking (i.e., to put a question to), but rather an order/command.” Request 14. This is not a persuasive argument. Asking covers requesting. *See Webster’s New World Dictionary, 3rd College Edition, 1988, 80* (Entry 3 - for “ask”: “to request; solicit”). Stinson is requesting, thus asking, the user to press an “OK” button.

“Claim 30” (Request 15)

We agree with the Appellant for the same reason given with respect to claim 21. Here the controller of the machine according to claim 29 is further “operative to cause the image data to be stored in correlated fashion with at least one of the data corresponding to at least one user input” We have reviewed Stinson and reconsidered our position. We do not find that Stinson

teaches, expressly or inherently, that an automated banking machine with a *controller* that is operative to cause the image data to be stored in *correlated* fashion with at least one of the data corresponding to at least one user input. Accordingly, we modify the Decision such that the rejection of claim 30 under § 102 is reversed.

“Claim 36” (Request 15)

The Appellant argues that the Board failed to consider step (d) of the claim. Step (d) calls for “operating the machine to correlate the check with the at least one user image as the electronic signature of the user for purposes of processing the check.” Request 15-16. We have reviewed the Brief. Although the Appellant discussed the rejection of claim 36 by incorporating remarks made in support of the patentability of previous claims (App. Br. 28), we do find statements made there questioning where in Stinson the subject matter of step (d) is taught. *See* App. Br. 28-29. In light of this, we have reviewed the record but do not find the argument persuasive. Stinson describes taking an image of a user and the image that would appear to be in connection with a check provided by the user. Furthermore, Stinson discloses that “[t]he data packet includes the information sent from the ATM 350 to the processor 300” (col. 9, lines 53-54) which would include the BMP file including an image of the customer and information about the check (i.e. front and back check images, MICR information, check amount). The ATM would be operated by the software and the claim does not limit how the check is “correlated” with the image. The same reasoning with respect to the “correlating” in claim 26

would apply here as well. The BMP file is “correlated” with the images of the check at least by being transmitted together.

For the foregoing reasons we do not find the arguments persuasive and accordingly deny the Request to the extent that it seeks to change our decision to affirm the rejection of claim 36.

“Claim 37” (Request 16)

In not finding the Appellant’s arguments persuasive as to the rejection of claim 37, the Board relied on the reasons for not finding the Appellant’s argument persuasive in challenging the rejection of claim 26. Decision 21. The Appellant argues that claims 37 and 26 are not the same. The Appellant argues that the Decision is in error because it relies on Stinson for features in claim 37 that are not in claim 26 and not taught in Stinson. Request 16.

We have reviewed claims 26 and 37. While method claim 37 substantially parallels apparatus claim 26, claim 37 does include a step of linking user identity data to a document “wherein the user identity data is linked so as to serve as the electronic signature of the user for the document” that does not appear in claim 26. Nevertheless, claim 37 states “operating the machine to *link* the user identity data obtained in (a) to a document to which a signature of the user has legal significance, wherein the user identity data is linked so as to server as the electronic signature for the document.” Emphasis added. A definition of “link” is “anything serving to connect or tie.” *See Webster’s New World Dictionary, 3rd College Edition, 1988, 80* (Entry 4 - for “link”). Again, the claim does not limit how the user identity data is “linked” to the document. In Stinson, the BMP image file is “linked” to the images of the check when being processed.

For the foregoing reasons we do not find the arguments persuasive and accordingly deny the Request to the extent that it seeks to change our decision to affirm the rejection of claim 37.

“Point #4” (Request 17)

Point #4 discusses inherency. The Decision does not raise a question of inherency. The Board could not have overlooked or misapprehended what it did not find.

CONCLUSION

We have carefully considered the arguments that the Appellant has set forth in the Request but, for the foregoing reasons, we do not find them persuasive as to error in the decision to affirm the rejection of claims 1, 6-15, 17-19, 21-27, 29, 33 and 35-38 under 35 U.S.C. §102(e) as being anticipated by Stinson. However, we grant the request to the extent that we modify the Decision to clarify the Board’s position as explained above and to reverse the rejection of claim 21.

GRANTED-IN-PART

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